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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,069	07/11/2001	Yoshiki Nakagawa	1581/00262	2380

7590

11/22/2002

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EXAMINER

WILSON, DONALD R

ART UNIT	PAPER NUMBER
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1713

6

DATE MAILED: 11/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/807,069

Applicant(s)

NAKAGAWA ET AL.

Examiner

D. R. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other:  |

**DETAILED ACTION**

***Restriction Requirement***

1. Restriction is required under 35 U.S.C. 121 and 372.
2. This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I, claim(s) 1-18, drawn to a vinyl polymer with a terminus group of formula (1).

Group II, claim(s) 19, drawn to a vinyl polymer with urethane group linkages to a terminus group of formula (1).

Group III, claim(s) 20-25, drawn to a vinyl polymer with a siloxane linkage to a terminus group of formula (1).

Group IV, claim(s) 26-28, drawn to a curable composition comprising a vinyl polymer with a terminus group of formula (1).

Group V, claim(s) 29-31, drawn to a curable composition comprising a vinyl polymer with a terminus group of formula (1), and further comprising reactive monomers and/or oligomers with polymerizable groups.

3. The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: As pointed out in the International Preliminary Examination Report, EP'036, JP'714, JP'102 and JP'403 disclose compositions encompassed by Claims 1-3, 6-9 and 16-18.

Accordingly, the special technical feature linking the two inventions, a vinyl polymer having at least one terminus of general formula (1), does not provide a contribution over the prior art

**13.2 *Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled***

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. (Underlining added.)

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4. In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.
5. To the degree that applicant will argue the inventions of Group I are generic to the invention of Groups II and III, this will not be deemed to be persuasive. Although the patent Office permits claims which optionally includes other components it doesn't consider such claims to be generic to the subcombinations.

The situation is frequently presented where two different combinations are disclosed, having a subcombination common to each. It is frequently puzzling to determine whether a claim readable on two different combinations is generic thereto. This was early recognized in *Ex parte Smith*, 1888 C.D. 131, 44 O.G.1183, where it was held that a subcombination was not generic to the different combinations in which it was used. To exemplify, a claim that defines only the subcombination, e.g., the mechanical structure of a joint, is not a generic or genus claim to two forms of a combination, e.g., two different forms of a doughnut cooker each of which utilize the same form of joint. See M.P.E.P. 806.04(c).

#### ***Election of Species Requirement***

6. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.
7. The genera of species are as follows:
  - a. polymer main chains (Groups I-V inventions),
  - b. molecular chain termini of general formula (1) (Groups I-III inventions),
  - c. diisocyanate compounds used to link the vinyl polymer with the chain termini of general formula (5) (Group III inventions),
  - d. molecular chain termini of general formula (5) (Groups III inventions),
  - e. silanol groups at vinyl polymer chain termini used to used to link the chain termini of general formula (6) (Group IV inventions),
  - f. molecular chain termini of general formula(6) (Group IV inventions),
  - g. polymerization initiators, including the specie of none present (Groups IV-V inventions),  
and
  - h. monomers and/or oligomers (Group V inventions).

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8. Applicant is required, in reply to this action, to elect a single specie for each of the above genera as appropriate to the elected group of inventions to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

9. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

10. The following claim(s) appear to be generic to the above species in their respective groups:  
Claims 1, 19, 20, 26 and 29..

11. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the same reasons set forth in the restriction requirement.

#### ***Conclusion to Restriction/Election Requirement***

12. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

13. A telephone call was made to Mr. Burton A. Amernick on 11-19-02 to request an oral election to the above restriction requirement, but did not result in an election being made.

14. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

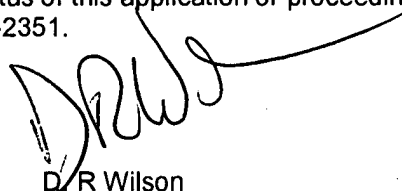
#### ***Future Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R Wilson whose telephone number is 703-308-2398.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

A handwritten signature in black ink, appearing to read 'D. R. Wilson', with a long horizontal flourish extending to the right.

D. R. Wilson  
Primary Examiner  
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